UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,856	03/18/2004	Jeffrey S. Poulin	L0562.70049US00	6542

23628 7590 03/22/2007

WOLF GREENFIELD & SACKS, PC
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

EXAMINER	
ERB, NATHAN	
ART UNIT	**PAPER NUMBER**
3628	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/803,856	POULIN, JEFFREY S.	
	Examiner	Art Unit	
	Nathan Erb	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-31 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-31 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Applicant's response to Office action was received on December 20, 2006.

3. With respect to the rejections of the claims under 35 U.S.C. 102(e), applicant argues that Connelly et al. fails to disclose "receiving a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece," as recited in claims 1 and 11, and "at least one feeder unit that receives a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece," as recited in claim 21. Applicant argues that these elements/limitations are not disclosed by Connelly et al. because the invention of Connelly et al. processes a stream of mail pieces containing only business reply mail pieces and no non-business reply mail pieces.

Examiner disagrees with applicant's arguments. In particular, Examiner cites two passages in Connelly et al. which disclose that both business reply and non-business reply mail pieces can be processed by the invention of Connelly et al. First, refer to column 3, lines 21-24, of Connelly et al. which states: "Bundles of mail pieces (not shown), such as: business reply cards, post cards, and the like, are loaded by an operator into the processing system 100 at the input feeder module 102." This passage is referring to mail pieces being input into the invention of Connelly et al. Of note here is the fact that the passage refers to both "business reply cards" and "post cards" as types of input mail pieces. A business reply card is simply a postcard that is also a business reply mail piece. If the term "post card" is referring to a business reply mail

piece, as applicant argues in the most recent response, then Connelly et al. is referring to business reply cards twice in a row in the sentence, which of course does not make sense. A more sensible interpretation of the passage is that the reference intended the term "post card" to have its normal meaning, that being any card used by itself as a mail piece, whether business reply or non-business reply. Not only is this the plain meaning of "post card," but this interpretation is more sensible since it is not completely redundant when following the term "business reply cards."

Examiner also cites a second passage which further supports that the invention of Connelly et al. can process both business reply and non-business reply mail pieces. That passage is column 8, lines 9-21, of Connelly et al. which states: "As yet still another example, those skilled in the art will recognize that with only minor modifications, the processing system 100 may be adapted to be operated by the postal authority. In this manner, the BRMPs 20 are processed at various receiving postal facilities around the country and the BRMPs 20 are not even delivered. This saves the postal authority the expense of having to ship all of the BRMPs 20 associated with each of the various mail campaigns to their respective delivery addresses. Also, the mail campaign senders receive the information more quickly because the BRMPs 20 are processed upon deposit with the postal authority instead of having to wait until they are received at the delivery address." Examiner is not aware of any postal authority which only receives business reply mail pieces as input mail pieces to its processing system. Therefore, this passage further discloses that both business reply and non-business reply mail pieces can be included in the input mail pieces of Connelly et al.'s invention.

In support of applicant's arguments, applicant states that because all processing of mail pieces in Connelly et al. depends on identification of Job ID code printed on the mail piece, the system would be unable to process non-business reply mail pieces, as such mail pieces would not have a Job ID code printed on them. In addition, applicant further states, in support of applicant's arguments, that Connelly et al. does not discuss how non-business reply mail pieces could be distinguished from business reply mail pieces or how non-business reply mail pieces could be processed or handled. In response to this, Examiner notes that the above two cites together very clearly demonstrate that Connelly et al. discloses that its invention may have input consisting of both business reply and non-business reply mail pieces. This is not negated simply because Connelly et al. may go into more detail about the processing of business reply mail pieces as compared to non-business reply mail pieces. Second, for purposes of addressing the independent claims 1, 11, and 21, these claims are not claiming any particular element/limitation describing how the non-business reply and business reply mail pieces are differentiated, just that the mail stream contains both types of mail pieces and that the system can identify and read the business reply mail pieces. This fairly general claim language is disclosed by Connelly et al., as supported by the above Examiner arguments. In addition, the independent claims do not contain any elements/limitations addressing how the non-business reply mail pieces could be processed or handled; such elements/limitations thus do not need to be disclosed by Connelly et al. for valid rejections of the independent claims under 35 U.S.C. 102. Therefore, the argument that Connelly et al. does not disclose how non-business reply mail pieces could be distinguished from business reply mail pieces or how non-business reply mail pieces could be processed or handled is not relevant with respect to the rejections of the independent claims. It should also be noted

that the fact that Connelly et al. performs actions specifically intended for business reply mail pieces and also can process a mail stream of both business reply and non-business reply mail pieces implies that Connelly et al.'s invention is capable of distinguishing and processing/handling non-business reply mail pieces.

Finally, it was well-known to one of ordinary skill in the art at the time of Connelly et al.'s filing that postal facilities can handle an input of mail pieces containing both business reply and non-business reply mail pieces and can distinguish the business reply from the non-business reply mail pieces. This must be done so that the postal service can determine how many business reply mail pieces have actually been returned and charge the appropriate amount of postage to the appropriate party. Therefore, when reading the passages of Connelly et al. cited above, there would be no mystery to one of ordinary skill in the art at the time of applicant's invention how a postal facility can handle an input of mail pieces containing both business reply and non-business reply mail pieces or how a postal facility can distinguish business reply from non-business reply mail pieces. One might suggest that this may be why Connelly et al. did not go into further details regarding the specific processing of non-business reply mail pieces as compared to business reply mail pieces.

Examiner appreciates the insight offered by Mr. Alfred T. Rundle in the declaration under 37 C.F.R. 1.132. Mr. Rundle raised issues which were carefully considered and addressed above in this Office action. However, neither the applicant nor Mr. Rundle adequately explained how Connelly et al. does not disclose the input mail stream containing both business reply and non-business reply mail pieces, especially in light of the two passages from Connelly et al. cited above in this Office action. Therefore, applicant's arguments are not persuasive.

Claim Rejections - 35 USC § 102

4. Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Martin Connelly et at. (US Patent 6,459,953), hereinafter referenced as Connelly.

As Per Claim 1:

Connelly discloses a method of processing business reply mail using a sorting apparatus (Col. 1, lines 55-57; business reply mail processing system and method), comprising acts of: receiving a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece (co1.3, lines 20-23), bundles of mail pieces, business reply cards, post cards and the like); automatically identifying the at least one business reply mail piece in the stream of mail pieces, (col.l, lines 59-60, organizing information associated with different mail campaigns into respective job data sets) and (co1.3, lines 20-23), bundles of mail pieces, business reply cards, post cards and the like); and in response to the act of identifying the at least one business reply mail piece, automatically reading information on the at least one business reply mail piece, (col.l, lines 60-62; using the job data sets to process the business reply mail pieces).

As Per Claim 2:

Connelly discloses method a wherein the act of automatically identifying the business reply mail piece further comprises an act of (col.1, lines 59-60, organized information associated): distinguishing the at least one business reply mail piece (BRMP) from the at least one non business reply mail piece (col.l, lines 59-60, organized information associated with

different mail campaigns into respective job data sets and using the job data sets to process the business reply mail pieces).

As Per Claim 3:

Connelly discloses a method wherein the act of automatically reading information on the at least one business reply mail piece further comprises acts of (col.l, lines 64-67, business reply mail processing system includes a scanner module): capturing at least one image [fig. 4(166b), image], of the at least one business reply mail piece; (col.l, lines 64-67, scanner module) and processing the at least one image to convert the information on the at least one business reply mail piece into electronic form (col.l, lines 65-67, reply mail processing includes control module in operative communication with the scanner module).

As Per Claim 4:

Connelly discloses a method wherein the act of automatically reading information (col.2, lines 4-5, reading the job ID code) on the at least one business reply mail piece further comprises an act of: reading a barcode on the at least one business reply mail piece (col. 2, lines 1-2, includes a job's ID code).

As Per Claim 5:

Connelly discloses a method wherein the at least one business reply mail piece (BRMP) is addressed to an intended recipient and the method further comprises an act of: discarding the at least one business reply mail piece without delivering the at least one business reply piece to

the intended recipient (col.2, lines 5-10, the data from the mail job database corresponds to the job ID code control the module using the processing data to read data from the business reply mail pieces).

As Per Claim 6:

Connelly discloses a method further comprising an act of: storing the information in electronic form, [fig.5 (506), scan and image; fig.5, stored record].

As Per Claim 7:

Connelly discloses a method wherein the business reply mail piece (BRMP) is associated with an originating entity and the method further comprises an act of: receiving the information at the originating entity, (col.3, lines 35-37; the mail pieces received at a central location are part of different mail campaigns).

As Per Claims 8:

Connelly discloses a method wherein the act of sending the information to the originating entity further comprises an act of sending (advanced) the information to the originating entity in electronic form, (Col. 3, lines 42-44, mail pieces are advanced along the path of travel through modules of the processing systems).

As Per Claim 9:

Connelly discloses a method wherein the acts of receiving, automatically identifying, and automatically reading are performed at a mail processing facility, (col. 2, lines 1-5, includes a job's ID code, the scanning module used for reading the job ID code).

As Per Claim 10:

Connelly discloses a method wherein the information includes a return address of a sender of the at least one business reply mail piece and a request for additional materials, and wherein the method further comprises act of: identifying the request for additional materials; and in response to identifying the request, sending the additional materials from the mail processing facility to the sender, (col. 3, lines 45-51, both sides of the mail piece may be scanned and co1.3, lines 56-60, collecting mail that has to be process).

As Per Claim 11:

Connelly discloses a method at least one computer readable medium encoded with instructions that, when executed on a computer system perform a method of processing business reply mail the method comprising acts of, [{col.l, lines 56-57}; a business reply mail processing system]: receiving a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece, [{col.l, lines 66-67 through {co1.2, lines 1-2} and (col.3, lines 20-23}, bundles of mail pieces, business reply cards, post cards and the like); transport module feeds BRMP in a path travel where the BRMP has I.D codes]; automatically identifying the at least one business reply mail piece in the stream of mail pieces, [{co1.2, lines 9-10}; read the field data from the business reply mail piece] and in response to the act of

identifying the at least one business reply mail piece, automatically reading information on the at least one business reply mail piece, [{col.2, lines 9-10}; read the field data from the business reply mail piece].

As Per Claim 12:

Connelly discloses a method that the at least one computer readable medium of claim 11, wherein the act of automatically identifying the business reply mail piece further comprises an act of, [{col.2, lines 9-10}; read the field data from the business reply mail piece]; distinguishing the at least one business reply mail piece from the at least one non-business reply mail piece, [{col.3, lines 22-24}; bundles of mail pieces, BRC, post cards, and the like].

As Per Claim 13:

Connelly discloses a method that wherein the act of automatically reading information on the at least one business reply mail piece further comprises acts of, [{fig 5, 508}; field data captured]: capturing at least one image of the at least one business reply mail piece, [{fig 5, 506}; scan and image]; and processing the at least one image to convert the information on the at least one business reply mail piece into electronic form, [{fig 6, 606}; correlate field data with post processing data].

As Per Claim 14:

Connelly discloses a method that wherein the act of automatically reading information on the at least one business reply mail piece further comprises an act of, [{col.2, lines 9-10}; read

the field data from the business reply mail piece]. reading a barcode on the at least one business reply mail piece, [{col.4, lines 41-48}; in barcode format]

As Per Claim 15:

Connelly discloses a method that wherein the at least one business reply mail piece is addressed to an intended recipient and the method further comprises an act of: discarding the at least one business reply mail piece without delivering the at least one business reply piece to the intended recipient, [{col.3, lines 61-62}; outsort bin got mail pieces that cannot be properly read].

As Per Claim 16:

Connelly discloses a method that wherein further comprising an act of: storing the information in electronic form, [{fig 5, 512}; store record].

As Per Claim 17:

Connelly discloses a method that at least one computer readable medium of claim 11, wherein the business reply mail piece is associated with an originating entity and the method further comprises an act of, [{col.3, lines 14-15]; mail campaign sender]: receiving the information at the originating entity, [{fig 1, 102}; input feeder]

As Per Claim 18:

Connelly discloses a method that wherein the act of sending the information to the originating entity further comprises an act of sending the information to the originating entity in electronic form, [{fig 6, 608}; initiate output activities]

As Per Claim 19:

Connelly discloses a method that wherein the acts of receiving, automatically identifying, and automatically reading are performed at a mail processing facility, [{fig 1}; business reply mail processing system].

As Per Claim 20:

Connelly discloses a method that wherein the information includes a return address of a sender of the at least one business reply mail piece and a request for additional materials, and wherein the method further comprises act of: identifying the request for additional materials, [{fig 6, 602}; identify new records]; and in response to identifying the request, sending the additional materials from the mail processing facility to the sender, [{fig 6, 608}, initiates output activities].

As Per Claim 21:

Connelly discloses a method wherein sorting apparatus comprising (Co1.1, lines 63-65, transport module feeds business reply mail in a path of travel): at least one feeder unit that receives a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece; and at least one controller that (fig.2, element 18; contains

class of mail): automatically identifies the at least one business reply mail piece in the stream of mail pieces; (fig.2, element 18; contains class of mail) and (col.3, lines 20-23}, bundles of mail pieces, business reply cards, post cards and the like): and in response to identifying the at least one business reply mail piece, automatically reads information on the at least one business reply mail piece, [fig.2, (18,19, 20), contains the class of mail, name of county, post office that issued it).

As Per Claim 22:

Connelly discloses a method wherein the at least one controller: distinguishes the at least one business reply mail piece from the at least one non-business reply mail piece, (col.3, lines 44-50, includes a plurality for output bins for collecting the mail pieces that have been processed).

As Per Claim 23:

Connelly discloses a method wherein the sorting apparatus includes at least one camera that captures at least one image of the at least one business reply mail piece and wherein the at least one controller processes the at least one image to convert the information on the at least one business reply mail piece into electronic form (Col.3, lines 44-47, scanner module is positioned adjacent to the path of travel so that mail pieces may be scanned and or imaged).

As Per Claim 24:

Connelly discloses a method wherein the act sorting apparatus further comprises a barcode reader that reads a barcode on the at least one business reply mail piece (col.2, lines 1-5; scanner module where the business reply mail piece includes a job ID code and filed data).

As Per Claim 25:

Connelly discloses a method wherein the sorting apparatus further comprises at least one output bin that receives mail pieces to be discarded, and wherein the at least one controller routes the at least one business reply mail piece to the at least one output bin, (col.3, lines 57-67, includes output bins fir collecting the mail pieces that have been processed and out sort bin for that cont be processed).

As Per Claim 26:

Connelly discloses a method wherein the at least one controller stores the information in electronic form, (fig 5, element 512; store record).

As Per Claim 27:

Connelly discloses a method wherein the business reply mail piece is associated with an originating entity and the at least one controller sends the information to the originating entity, (fig 6, element 600,606, 608; correlate data with post processing data, initiate out put activities).

As Per Claims 28 and 29:

Connelly discloses a method wherein the at least one controller sends the information to the originating entity in electronic form, [Co1.5, lines 57, dispatch the materials to the responder].

As Per Claim 30:

Connelly discloses a method located at a mail processing facility, [col.3, line 38; central location).

As Per Claim 31:

Connelly discloses a method wherein the information includes an address of an initial recipient of the business reply mail piece, [(co1.4, lines 48-51; the recipient ID code may be used for a unique identifier that distinguishes each recipient).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. **Examiner's Note:** Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Erb whose telephone number is (571) 272-7606. The examiner can normally be reached on Mondays through Fridays, 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nathan Erb
Examiner
Art Unit 3628

nhe

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER